

### **Remarks**

Claims 13-15 and 58-60 are pending in this application. Pursuant to a restriction requirement, claims 1-12 and 39-57 are canceled without prejudice to Applicants' right to pursue the subject matter recited by them in one or more divisional, continuation or continuation-in-part applications. Claims 16-19 are also canceled without prejudice. The title has been amended to more precisely reflect the subject matter of the pending claims. The pending claims are entirely supported by the specification as originally filed. No new matter has been introduced.

A. **The Rejection Under 35 U.S.C. § 102(a) Should Be Withdrawn**

On pages 3-4 of the Office Action, the claims are rejected as allegedly anticipated by U.S. Patent No. 6,391,875<sup>1</sup> to Morgan *et al.* ("the '875 patent"). In particular, it is alleged that the claims are anticipated because the '875 patent discloses a method of treating an affective disorder using (S,S)-hydroxybupropion. Office Action, page 4. However, the pending claims do not recite any of the indications disclosed in the '875 patent (*e.g.*, depression). Because a prior art reference must disclose each and every limitation of a claim in order to anticipate it, Applicants respectfully request that this rejection be withdrawn. *See, e.g., Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

B. **The Rejection Under 35 U.S.C. § 103(a) Should Be Withdrawn**

On pages 4-5 of the Office Action, claim 16 is rejected as allegedly obvious over the '875 patent in view of WO 99/17803 to Cary ("the '803 publication"). In view of the cancellation of claim 16, the rejection is obviated, and Applicants respectfully request that this rejection be withdrawn.

It is further alleged in the Office Action that claim 18, which is now part of claim 13, is obvious over WO 99/38499 to McCullough *et al.* ("the '499 publication") in view of the '875 patent. Applicants respectfully point out that the '499 publication is not prior art to this application. This application claims priority to U.S. Provisional Application No. 60/122,277, which was filed on March 1, 1999. The

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<sup>1</sup> The '875 patent is an equivalent of WO 99/37305. Although WO 99/37305 was cited for the rejection, the Examiner refers to the portions of the '875 patent in the text of the rejection.

publication date of the '499 publication is August 5, 1999. As such, the '499 publication is not a prior art reference, and thus, Applicants respectfully request that this rejection be also withdrawn.

C. The Double Patenting Rejection Should Be Withdrawn

On pages 7-8 of the Office Action, the claims are provisionally rejected under judicially created non-statutory double patenting as allegedly unpatentable over the claims in the co-pending Application No. 09/987,931 ("the '931 application"). In light of the claim amendments made herein, and those concurrently made in the '931 application, Applicants respectfully request that the rejection be withdrawn.

D. Statement Pursuant to 37 C.F.R. § 1.604(b)

Pursuant to 37 C.F.R. § 1.604(b), Applicants wish to direct the Examiner's attention to U.S. Publication Nos. 2003/0083330A1, 2003/0064988A1, and 2003/0032643A1, copies of which are enclosed in the Supplemental Information Disclosure Statement submitted herewith. Pending claims 13-15 and 58-60 define, in part, the same patentable invention as recited by claims in these publications. In addition, the Examiner's attention is also directed to U.S. Publication No. 2003/0027827A1, a copy of which is also enclosed in the Supplemental Information Disclosure Statement submitted herewith.

**Conclusion**

Applicants respectfully submit that all of the pending claims are allowable, and request that rejections directed to the claims be withdrawn.

No fee is believed due for this submission. Should any additional fees be due for this submission or to avoid abandonment of the application, please charge such fees to Jones Day Deposit Account No. 503013.

Respectfully submitted,

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Enclosures